
IN THE
United States
Circuit Court of Appeals,
FOR THE NINTH CIRCUIT. //

Francis M. Townsend, Milon J. Trumble and Alfred J. Gutzler, doing business under the firm name of Trumble Gas Trap Co.,

Appellants,

vs.

Lorraine Corporation, a corporation,

Appellee.

APPELLANTS' BRIEF.

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FILED
FEB 14 1930

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APPELLANTS' BRIEF.

Appellants were plaintiffs and appellee defendant in a suit involving infringement of U. S. Letters Patent No. 1,269,134 granted June 11, 1918 on an application filed November 14, 1914 for the invention of Milon J. Trumble in Crude-Petroleum and Natural-Gas Separators.

This appeal is from an order in the form of an order denying a preliminary injunction. While the form of the proceedings and the form of the order is the denial of plaintiffs' motion for a preliminary injunction restraining defendant pending suit, the decision is and was on the merits and was and is in effect a final adjudication. The decision is not based upon any controversy of facts. Believing therefore that the issues were and are fully and

finally before the Court, plaintiffs have taken this appeal and submit that the decision of the District Court is erroneous in law.

The Trumble patent has heretofore been fully litigated. It has been fully considered by this Court. (290 Fed. 54, opinion by Judge Dietrich.)

Such prior adjudication was in a suit wherein the present plaintiffs were plaintiffs and David G. Lorraine was the original defendant. While such suit was pending, said defendant David G. Lorraine sold and transferred his business of manufacturing oil and gas separators to the present defendant Lorraine Corporation which was organized for that purpose. The Bill of Complaint alleges:

“That during the pendency of the said suit the defendant therein David G. Lorraine transferred his then existing business of manufacturing crude petroleum and natural gas separators to the defendant herein Lorraine Corporation which corporation thereupon became the successor to the said David G. Lorraine in the manufacture of crude petroleum and natural gas separators, and contributed to and participated in the defense of said suit.” [Tr. Rec. p. 6, Bill of Complaint paragraph VIII.]

This is admitted in defendant’s answer (paragraph VIII):

“Admits that during the pendency of said suit the defendant therein David G. Lorraine transferred his then existing business in the manufacture of crude petroleum and natural gas separators to the defendant herein Lorraine Corporation, which corporation thereupon became the successor to the said David G. Lorraine in the manufacture of crude petroleum and natural gas separators, and continued to and participated in the defense of said suit.” [Tr. Rec. bottom of page 67.]

The validity and interpretation and scope of the Trumble patent is therefore *res adjudicata* between the parties. Not only did the present defendant participate in and control the defense of the prior litigation, particularly conducting and controlling the appeal to this Court, but also defendant purchased the business of defendant David G. Lorraine, *pendente lite*, and was thereby completely bound by such adjudication. This rule of law is so well settled and this Court is so familiar therewith that plaintiffs will cite only examples of decisions illustrating such rule.

See:

Hart Steel Co. v. Railroad Supply Co., 244 U. S. 294; 61 L. Ed. 1148;

Lenk v. Lasher-Peerblow Co., 27 Fed. (2d) 958;

Elliott Co. v. Roto Co., 242 Fed. 941 (C. C. A.);

Lyons v. Baer & Wild, 26 Fed. (2d) 599 (C. C. A.).

The original suit was decided by the District Court (283 Fed. 806, Judge Wolverton) holding the Trumble patent valid and infringed by the various oil and gas separators or "gas traps," as such devices are commonly known in the art.

This Court affirmed such decree insofar as sustaining the validity of the patent. It materially limited the scope thereof and reversed the District Court in its holding that certain of the defendant's traps were infringements.

It is clear, therefore, that the validity of the patent is not and cannot be an issue in this case. The validity of the patent is *res adjudicata*.

It is equally clear that both parties being bound by such prior adjudication (the scope of said letters patent

having been finally judicially determined in such suit as to which both of the parties here were parties), the sole question in this case must be, are the oil and gas separators or "gas traps" complained of herein infringements of said Trumble patent *within the adjudicated scope of said patent?*

Pursuant to the mandate of this Court, the District Court on August 15, 1923, entered an interlocutory decree in said original suit wherein it again affirmed and decreed the validity of said Trumble patent. Subsequently such interlocutory decree matured into a final decree, the accounting thereunder having been waived. [Tr. Rec. pp. 110-11, par. I of license agreement of April 2, 1926.]

As a result of this Court's decision (290 Fed. 54) defendant was left free to make, use and sell gas traps of the construction therein identified as "Model 2." There were two slightly variant forms of this "Model 2." These are illustrated in Defendant-Appellant's Opening Brief in said prior case (see pages 88-89 thereof). We shall hereinafter reproduce these two drawings in an insert to this brief illustrating the various gas traps produced by defendant and shall direct the Court's specific attention to the differences in construction and mode of operation found by this Court as existent between the "Model 2" constructions and the Trumble invention.

We wish now to particularly direct this Court's attention to that class of proof which speaks louder than words,—defendant's actions or conduct.

In said prior litigation defendant asserted that the so-called "Model 2" construction was superior to the Trumble invention.

In said prior litigation defendant belittled the Trumble invention to this Court, but defendant's conduct and acts since said decision amount to a demonstration of the practical value and importance of the Trumble invention. When we here say the Trumble invention we mean the Trumble invention as defined by this court in its said decision. (290 Fed. 54.)

In "Appellant's Opening Brief" in said prior case (No. 3945 in this Court) on page 14 defendant-appellant says:

"Another error of sufficient importance to justify brief preliminary notice: In the trial court's opinion [Transcript of Record, middle of page 541], the court said: 'Utility has been abundantly proven by the success achieved by plaintiffs' device.' If this intended to imply that there is any evidence in the record tending in any degree to show that Trumble contributed anything whatever of value or utility to the art, it is, as we shall later show, clearly erroneous. So far as the evidence discloses, the device illustrated and described in the patent in suit was only useful *insofar as it incorporated means and devices long known and used in the art for identical purposes.* There is no evidence whatever in the record tending to show that any possible difference between the device of the Trumble patent and the prior art, either alone or in combination with other devices as set forth in the claims was in any respect advantageous or had any utility. The only basis of the finding of utility, therefore, was presumption—not evidence." (Italics as they appear in said brief.)

In Defendant-Appellant's Opening Brief (Case No. 3945) defendant says:

"This method of close and fine interpretation is often necessary where there has been a *valuable contribution to the art*, which it is desired to protect, but where is the contribution of Trumble?" (Italics defendant's.)

In said defendant-appellant's reply brief in said case No. 3945 in this court, defendant states:

“* * * the fact that the Trumble trap was of recognized value *only insofar as it incorporated devices long and well known in the prior art.*” (Italics reproduced from said brief.)

This Court held that defendant's “Tonner No. 3” trap was an infringement. Defendant asserted that it had built only one “Tonner No. 3” type trap; that that construction was inferior to “Model 2”; that the reason for abandoning the “Tonner No. 3” construction was that the “Model 2” was of superior efficiency and utility; that “Model 2” did not infringe; that it did not embody a construction as did the construction provided in the Trumble patent and as adjudicated present in the “Tonner No. 3” trap wherein means were provided for spreading out the oil and conducting the oil onto the wall of the separator. Defendant asserted that “Model 2” *“employing no element whatever performing such double function of spreading and conducting are not infringements.”* (Italics that of Appellant's Opening Brief, Case No. 3945, page 69.) Notwithstanding defendant's assertions in said case that gas traps “without any element whatever performing such double function of spreading and conducting are not infringements” and were superior to the Trumble invention and to the “Tonner No. 3” construction and that the latter was abandoned because of the superiority of “Model 2.”

This suit is based upon defendant's (having from necessity at last), come to a Trumble construction embodying such element for performing such double function of spreading and conducting. This after defendant had

built and tried out in actual oil well service and use at least five other constructions.

The history of these respective constructions shows defendant gradually encroaching upon the Trumble invention as interpreted by this Court. Each subsequent new form more closely embodied the Trumble inventive thought. Until at last in the devices herein complained of, defendant has produced therein an actual element performing such double function of spreading and conducting in substantially the same manner and for the same purpose and in the combination which this court has held to be the scope of the Trumble invention.

Defendant cannot now be heard to assert that the Trumble invention "*was only useful insofar as it incorporated means and devices long known and used in the art for identical purposes.*" (Italics defendant's.) On the contrary the present appeal involves two of defendant's constructions which, (as we shall point out specifically), abandon entirely the defendant's early theories and constructions and use means clearly equivalent to Trumble for slowing down the incoming stream of oil and gas, (reducing velocity,) permitting partial initial separation of gas and oil by permitting initial expansion, *and* for actually not only directing but conducting and spreading the oil onto the surface of the gas-trap wall.

These two of defendant's gas trap constructions so directly charged in this suit to infringe, are identified and described in the affidavits of Milon J. Trumble [Tr. Rec. pp. 39-47, at p. 45], as Figs. 5 and 6 of "Exhibit A," and in Exhibits C and D; John D. Hackstaff [Tr. Rec. pp. 51-60, last paragraph p. 57]; and William McGraw

[Tr. Rec. pp. 16 to 25, last paragraph p. 21 to p. 24]. Pursuant to the stipulation [Tr. Rec. p. 157] and to the stipulation of February 21, 1930 (in this court), the same exhibits are referred to by each of these witnesses and printing of these exhibits or drawings in the transcript has been waived. The Clerk has prepared copies thereof under this stipulation.

This series of exhibits so covered by this stipulation also illustrates the so-called "Tonner No. 3" trap (Exhibit A to the Bill of Complaint), and seven (7) constructions of defendant's traps designed and made by defendant after this court's decision in the original case. Intervening between the "Tonner No. 3" and these seven (7) constructions were the "Model 2" constructions of the original case. These two "Model 2" constructions are substantially the same, except that the so-called bell nipple was machined off in one of such constructions and placed in closer proximity to the partition wall, against which part of the incoming stream of oil was directed. Otherwise, the two "Model 2" constructions were the same and we herein treat them as the same. This, for the reason that this court in deciding the original case treated them as the same, there being no distinction between them in view of the court's decision as to the scope of the Trumble invention.

These two "Model 2" constructions are illustrated in the exhibit drawings referred to in the affidavit of David G. Lorraine and were reproduced pursuant to said stipulation. They are also illustrated on pages 88 and 89 of defendant-appellant's opening brief in said Case 3945.

There is no controversy as to the respective constructions of these ten (10) different gas traps, so made from time to time by the defendant.

These ten different constructions completely refute defendant-appellant's original contention in said original case (No. 3945) that there was nothing new or of value in the Trumble invention. The development by defendant (Appellee herein) of its commercial product shows conclusively the necessity and demand for the incorporation into a completely successful gas trap of the Trumble invention. At the end of this brief we have inserted upon a single sheet, drawings illustrative of defendant's ten gas trap constructions.

Very shortly after the decision of this court in said original case, defendant showed that it was not satisfied with the so-called "Model 2" gas trap construction. It is a dependable inference that such construction was not satisfactory. This, because defendant abandoned the "Model 2" construction and then devised what is here known as "Model 16." (The record does not show, and we are unable to state whether there intervened between the "Model 2" construction and "Model 16" construction, thirteen (13) other gas trap constructions made by defendant. If so, the litigation does not disclose what their variations were. The most we know is that such other thirteen variations were not the subject of litigation between the parties.)

When defendant brought out said "Model 16" construction, appellant believed it to be a violation of the injunction of the original case, under the interpretation and

scope given the Trumble invention by this Court. Appellants therefore moved in the District Court for an order in civil contempt adjudging defendant in contempt. This motion was heard by the then Judge Benjamin F. Bledsoe. Judge Bledsoe dismissed the contempt proceedings, saying:

“This model was not a colorable adaptation of either of the models held to be infringements by Judge Wolverton,” etc.

* * * * *

“Without indicating any opinion as to whether or not Model 16 is an infringement of the patent as construed by the Circuit Court of Appeals, 290 Federal 54, at page 59, I am constrained to hold that it was not a violation of the injunction of Judge Wolverton, and that therefore the proceedings in contempt should be dismissed.” [Tr. Rec. pp. 142-143.]

Subsequently, plaintiffs applied for and secured leave in said original suit to file a supplemental bill of complaint, alleging in said suit infringement by said “Model 16.” At that time the decree in said original suit was interlocutory, the accounting order having not been completed.

Thereafter, said litigation was settled and a final decree therein entered waiving the accounting and maintaining only the original injunction in force and effect. This was by a compromise and settlement. It is reflected in the agreement of April 2, 1926, between David G. Lorraine, and the Lorraine Corporation (defendant herein) as first parties, and plaintiffs as second parties. [See Tr. Rec. pp. 109 to 112.]

As a part of such settlement agreement, these plaintiffs granted to the defendant-appellee herein a limited

license under the Trumble patent in suit. [See Exhibit A to the Bill of Complaint, Tr. Rec. pp. 11 to 12.] The two drawings referred to in this license agreement illustrate the so-called "Tonner No. 3" and "Model 16" traps, respectively. Defendant was thereby licensed under the Trumble patent to make these two constructions. (Certain settlements of other litigation also attended this settlement of April 2nd, 1926. We will not refer in detail thereto, as they have no bearing upon the validity, scope or infringement of the Trumble patent.)

But, defendant found "Model 16" construction unsatisfactory. We shall hereafter refer to the reasons underlying defendant's contention that "Model 16" does not infringe. Let us first consider the continuous trend of defendant's activities toward a more and more complete adoption and use of the Trumble invention as its scope is defined by this Court in its previous decision.

Not satisfied with "Model 16," defendant thereafter made six (6) more gas trap constructions. It is the last two of these, referred to as Figs. 5 and 6 of Exhibit A to plaintiff-appellee's said moving affidavits, which are directly charged to infringe. An examination of these step-by-step changes of construction shows a continuous approach closer and closer to the specific construction of the Trumble patent. They show the necessity experienced by defendant of appropriating the whole of the Trumble invention to have a satisfactory commercial gas trap.

This court held the "Tonner No. 3" construction to infringe. It is believed that the full reasons therefor are clearly set forth in that portion of this court's opinion commencing with paragraph (2) on page 59 of 290 Fed-

eral. If the court will refer to the illustrative sheet of drawings inserted at the end of this brief, there will be found the drawing of "Tonner No. 3" produced by defendant in the prior litigation. It is to be noted that the main cylindrical chamber of the gas trap is divided into two main portions by the vertical partition 2. The chamber at the right of this partition is again divided into two operative chambers by the deflector or baffle plate 3. That portion of the chamber above the baffle plate forms an initial expansion chamber; the oil from the inlet 4 "spreads approximately the whole body of oil in an unbroken condition to the adjacent segment of the chamber wall, down which it flows substantially as in the Trumble device." (290 Fed. bottom p. 59.) The court held this baffle plate 3 the equivalent of the Trumble cone. The "Model 2" construction substituted for the baffle plate 3 of "Tonner No. 3" only a down-turned pipe nipple. This is exemplified in the second and third drawings by the numeral 4. The sole difference between the two constructions of "Model 2" was that in one the nipple was arranged in the center of the chamber between the main wall 1 of the trap and the partition 2. In the other "Model 2" construction a portion of the nipple was machined off so that it could be brought into close contact with the partition 2. This construction the court held did not infringe, because it did not contain the mechanical element or means of the Trumble combination, i. e., the baffle plate or distributing means by which the oil was distributed and directed onto the wall of the trap. But, on the contrary, with this "Model 2" construction—

" * * the incoming stream is broken up by
* * * the bell-shaped nipple, and in part splashed
against the chamber wall and partition, the other part

falling free into the settling pool. Some of the portion striking the partition plate and chamber walls doubtless flow down the surfaces to the pool below, and, so flowing in a sort of a sheet, is suggestive of the Trumble process. But the filming is only slight and incidental, and apparently these features of appellant's apparatus are primarily designed to get the requisite exposure for the escape of gas, by dividing the body of the froth into drops and splashes and streamlets, rather than by spreading it as a sheet or film on a solid backing, and also to guard the settling pool against direct discharge into it of the incoming stream at a high velocity, causing violent agitation and interfering with the separation, by gravitation, of the sand and water from the oil." (Opinion of Court, 290 Fed. top of page 56.)

This court, after this explanation of said "Model 2" construction, says:

"Our conclusion is that, in the light of the prior art and the patentee's interpretation of his claims in the Patent Office, the claims are to be read only upon apparatus by which substantially the whole body of oil is spread as a film or thin sheet on a backing wall, and is not, in the course of the process of separation, broken up by any means into drops or streamlets; and, if so read, they do not reach the structure exhibited in the drawings of appellant's patent or in the model identified by the bell-shaped discharge nipple." (Opinion of Court, 290 Fed. page 59.)

This court was persuaded to this decision by defendant's contention that with the "Model 2" there was no delivery of the oil onto the wall of the trap in the sense of the Trumble patent; this is reflected in the court's statement that the main operation of the "Model 2" was the dropping of the oil to the settling pool in "drops and splashes and streamlets,"—"the filming is only slight and

incidental.” (Page 56 of 290 Fed.) In this connection we remind the court that in appellant’s opening brief, under the caption “Defendant’s Model 2 does not infringe” on page 90, defendant says:

“It would seem obvious that the oil coming through the inlet opening 4 *must* in large part fall to the bottom of the separator without striking the walls at all. Indeed, the trial court distinctly so found, stating [near the top of page 538 of the transcript of record] that part of the oil descends ‘by gravity *without reaching either wall.*’” (Italics defendant’s.)

This is further borne out by further consideration of appellant’s said opening brief in the said case 3945. Defendant had been arguing that the “Model 2” construction did not contain any means (i. e., a spreading cone, baffle or its equivalent) and therefore did not infringe. Defendant on page 94 of said brief says:

“We, therefore, turn to the specification and drawings of Trumble, as well as to his file wrapper contents, to discover what the parties to this patent contract meant when they used the language ‘means to distribute the oil over the wall of the chamber,’ etc. We have seen that Trumble defines this ‘means’ very specifically, in connection with the statement of what he supposed he actually added to the art, as ‘an imperforate baffle-plate adapted to spread the whole body of oil to the outer edge of the vessel,’ i. e., *distribute the oil equally around and over all the walls of the chamber.* Manifestly, there is no such element in defendant’s Model No. 2. This element is described as being *within* the chamber. The oil does not reach the chamber until it is discharged from the opening in the so-called bell-shaped nipple, and upon entering into the chamber falls in large part to the bottom of the chamber, only incidentally striking or splashing on the walls. We, therefore, submit that defendant’s Model No. 2, either with the so-called nip-

ple set against the partition or away from the partition, does not infringe.” (*Italics defendant’s.*)

The fourth view or drawing of this insert is of the type or “Model 16,” produced by defendant after this court’s said decision, and which was the subject of the civil contempt proceedings. This is the construction that Judge Bledsoe held “was not a colorable adaptation,” and reserved any opinion as to infringement. In this Model 16 construction the partition comparable to the partition 2 of the “Tonner No. 3” and “Model No. 2” constructions was used. Defendant abandoned the use of the baffle 3 of the “Tonner No. 3” and abandoned the use of the nipple 4 of the “Model No. 2.” In the chamber formed between the outer wall of the gas trap and the said partition there was formed a tight or closed box 3 open only at its bottom. Into this box extended the inlet nozzle 1 which was in the form of a 6-inch nipple. This nipple was cut away as indicated at 2 in the drawing; the incoming oil was discharged into this box from the cutaway portion 2 of the nipple. The only outlet from this box was through the bottom openings 4 of the box 3; the oil dropped directly from these openings 4 into the body of oil in the trap.

The fifth drawing of this insert series of illustrations illustrates the next form of construction produced and experimented with by the defendant corporation after the grant of the license on April 2, 1926. [Tr. Rec. p. 11.] This construction is referred to as Fig. 1, Exhibit A, and described in detail in the affidavits of McGraw [Tr. p. 33], Trumble [Tr. p. 39], Hackstaff [Tr. p. 51]. It is noted that defendant abandons the use of a partition like the partition 2 of the former gas traps. It provides

only a closed passageway or trough or conduit which is closed at top, sides and bottom; the inlet is from the side of the trap into this passageway or conduit; the outlet is at the open end of the passageway; the closed conduit or passageway is arranged horizontally. The fact that defendant after constructing this trap discarded it, raises a strong inference against its commercial practicality. It is to be noted that this construction did not embody any baffle means by which the oil was delivered onto or spread on the trap wall,—comparable to the baffle of “Tonner No. 3” or Trumble’s cone. The proofs show that such cone or baffle means is the element which makes “gas traps” commercially successful.

The sixth drawing of this insert series is Fig. 2 of Exhibit A of the affidavit of McGraw, et al. It is marked “2-A”. See affidavit of McGraw Trans. Rec. last paragraph p. 17 and Trumble Trans. Rec. p. 42. In this device of Fig. 2 the oil from the well is delivered to the inside of the separator into a chamber formed vertically between a vertically extending plate or wall (indicated in the upper figure by dotted lines) and the wall of the trap or separator. The gas and entrained oil rises from such chamber upwardly through a nipple into a circular enclosed passageway or conduit which is arranged above the oil and gas inlet. This circular conduit extends around the inside of the separator or trap wall. The lower surface or bottom of such conduit beyond the vertically extending wall is formed with an annular slot between such bottom of the conduit and the inner surface of the trap wall, whereby the accumulated oil in the conduit is discharged against the inner wall of the separator and flows downwardly thereover, the gas passing downwardly

through the annular slot thus formed and passing upwardly to the top of the trap, from which it is discharged. Evidently this type was not successful and thereafter defendant made and tried out the type and construction of trap shown in the next succeeding drawing of this series, marked "Fig. 3" and "3-A".

The trap of said Fig. 3 is described in the affidavits of McGraw [Trans. Rec. p. 18] and Trumble [Trans. Rec. p. 43.] With this form and construction of defendant's trap the enclosed circular trough or conduit is used but such trough is arranged helically extending from the inlet downward. The inlet of the oil and gas is from the trap directly into this trough or conduit, the conduit is closed at the sides and top and the discharge is from the open end of the conduit. A series of openings were provided in the bottom of the conduit along the inner surface of the gas trap wall, as indicated in dotted lines in the top view of Fig. 3. This construction was not successful. It was unsatisfactory, for we find defendant trying another experiment—Fig. 4.

The eighth drawing of this series insert (Fig. 4) illustrates another experimental form constructed by defendant. This form is explained in the affidavit of McGraw [Trans. Rec. p. 19] and Trumble [Trans. Rec. p. 43.] This form is similar to Fig. 1 of this series except that the circular trough extends entirely around the inner wall of the shell and is arranged helically so that the outlet end of the trough is directly underneath the inlet. The trough is closed at the top, side and bottom with the exception that the bottom wall is discontinued at a point approximately three-fourths of the distance around the separator from the inlet opening, the bottom from such

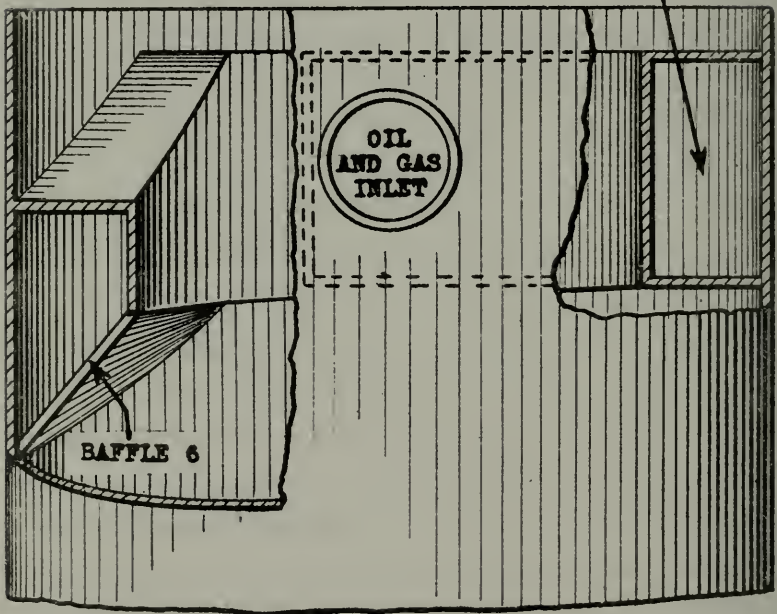
point to the discharge or open end of the trough being open. This construction was another unsuccessful experiment. After it, we find defendant designing and constructing the traps which infringe and upon which this suit is based.

After this period of development commencing with "Tonner No. 3", producing the non-infringing "Model 2", the licensed "Model 16" and the unsatisfactory experimental traps Fig. 1, Fig. 2, Fig. 3 and Fig. 4, defendant produced another trap. Two slight differences of construction of this final trap are illustrated in the ninth and tenth drawings of this series. They are marked "Fig. 5" and "Fig. 6" respectively. These are the traps that have because of their reappropriation of the Trumble invention been defendant's final success.

These traps of Figs. 5 and 6 are explained in the affidavits of McGraw [Tr. Rec. pp. 20-22]; Trumble [Tr. Rec. pp. 43-44], and Hackstaff [Tr. Rec. bottom page 54 and commencing with last paragraph p. 57.] In these two forms of gas trap an enclosed conduit is used. This conduit extends around the inner surface of the trap. It is closed at the top, inner side and bottom. The other side wall or surface is formed by the wall of the trap. The inlet of oil is from the outside of the trap into this conduit. This conduit forms an expansion chamber by means of which the velocity of the incoming stream of oil is slowed down and quiescence secured enabling initial separation of the gas from the oil. The outlet from this enclosed chamber or trough is by means of a baffle or spreading directing plate 6. The two forms of Fig. 5 and 6 differ only as to the mechanical means of connecting the baffle or distributing plate 6 to the

DEFENDANT'S FIG. 6 TRAP
See Model
EXHIBIT A-6

ENCLOSED TROUGH FORMING EXPANSION CHAMBER
REDUCING VELOCITY, AND SECURING QUIESCENCE.
ALL THE OIL IS THROWN ONTO THE INNER CURVED
SURFACE OF THE TRAP WALL WHICH FORMS THE
OUTSIDE WALL OF THIS TROUGH.



conduit or trough. In Fig. 5 two pieces of metal are used and joined together to make a continuous surface while in the construction of Fig. 6 only one piece of metal is used. The effect is practically the same. It is to be noted that the baffle 6 does not conform to the bottom of the trough or conduit. It is not only directed slightly downwardly but it is directed downwardly and inwardly toward the wall of the trap, assuring all of the oil passing downwardly toward and against the inner curved surface of the trap wall. In normal operation all or at least substantially all of the oil is thereby not only directed toward but actually brought onto and distributed onto the inner surface of the trap wall and thereby spread out in the same manner as in the Trumble patent embodiment of the Trumble invention and in the "Tonner No. 3" infringement.

In addition to the drawings there are in evidence forming part of the record herein two small sheet-iron models marked Exhibits A-5 and A-6, respectively, to the affidavit of William McGraw. By reference to these the slight difference between traps and the construction of Figs. 5 and 6 will be apparent. We have inserted opposite this page a drawing which is illustrative of this type or construction of gas trap. This drawing illustrates the relation of the downwardly positioned baffle 6 which is inclined toward the curved inner surface of the outer wall of the gas trap and forms a tight joint with such wall.

The enclosed trough of this construction is to slow down the velocity of the gas and oil entering the trap and to deliver substantially all of the oil onto the inner wall of the trap. In order to insure this final result,

defendant has adopted and used an inclined spreading and directing surface formed by the baffle 6. This corresponds to the baffle 3 of "Tonner No. 3" and to the cone of the drawing of the Trumble patent. This baffle is not spaced away from the wall as was the edge or end of the baffle 3 of the "Tonner No. 3" trap, of which this court said:

"Possibly, as contended by appellant, the partition is less instead of more than one-third of the distance from the wall; but the precise location is not highly material. The baffle plate is thought to be the equivalent of the Trumble cone, and spreads approximately the whole body of the oil in an unbroken condition to the adjacent segment of the chamber wall, down which it flows substantially as in the Trumble device." (290 Fed. bottom of page 59.)

With this type Fig. 5 or Fig. 6 construction, the pipe carrying the oil from the oil well to the trap is of much smaller cross-sectional area than the enclosed trough or conduit in the trap into which the pipe delivers the intermingled gas and oil. Therefore, when the gas and oil from the well enter this trough the mixed oil and gas is allowed to expand and the velocity thereof is reduced. This trough being circular and fastened to the circular inner wall of the gas trap, the oil is thrown to the outside of the trough, *i.e.*, the inner surface of the wall of the gas trap. Therefore, when it leaves the trough it is projected onto the inner surface of this curved wall of the trap. The delivery end of the trough terminates also in the baffle 6, which is an extended spreading surface and serves also to direct any oil, not carried along on the inner surface of the wall of the trap, onto such wall. The delivery end of the trough, as formed by this baffle 6, is several inches lower than the end of the trough where

the gas and oil enter. The baffle 6 forms a spreading and directing surface in continuation of the surface of the trough, which baffle surface direct any oil thereon to and delivers such oil onto the inner surface of the separator, where all oil flows down in a relatively thin film or body. The oil in this trap does not pour out of the end of the trough in drops or streamlets without touching the wall of the separator, as in "Model 2".

In this Fig. 5 or Fig. 6 gas trap construction the cross-sectional area of the closed trough is such that the velocity of the incoming oil and gas is slowed down, the turbulence is thereby materially lessened and the requisite quiescence given to the oil and gas, the free gas immediately rising to the top of the trough. As the trough corresponds to the arc of the circle of the gas trap wall, the oil due to its velocity is thrown onto the curved inner surface or wall of the trap. Such oil as reaches the end of the trough on the bottom thereof is directed and conducted by the baffle 6 onto the curved inner surface of the wall from the trap. It is thus seen that all or substantially all of the oil is spread onto the inner surface of the wall of the trap. Essentially, it is in a relatively thin film and flows essentially quiescently down the wall into the body of oil in the bottom of the separator. While the oil is flowing down such inner surface of the separator wall (as a backing wall), the gas freed from such downwardly flowing film of oil escapes toward the center of the "gas trap" and rises to the upper portion thereof. By the construction of this trough with the deflector plate or baffle 6 at the delivery end guiding and directing the flow of oil onto the curved inner surface of the tank wall, it is highly improbable,

if not impossible, for any substantial portion of the oil to drop from the end of the trough directly into the body of oil in the separator and in drops or streamlets, as Judge James in his opinion has assumed might take place.

We respectfully submit that to arrive at this conclusion Judge James evidently considered the bottom of the trough as horizontal at the discharge end and had in mind that the wall of the separator was flat and not curved.

We thus see that the enclosed trough in these Fig. 5 and 6 traps forms an initial expansion and separation chamber, and the surfaces of such trough, being positioned as they are, form mechanical means for delivering the oil directly onto the inner curved surface of the trap wall. That defendant in order to insure all or substantially all of the oil being delivered onto such inner curved surface has provided at the end of the trough a mechanical means (*i.e.*, the baffle 6) to direct, conduct and spread the oil onto the inner surface of the wall of such chamber to flow downwardly thereover (as expressed in claim 1 and as construed by this court in 290 Fed. 54). We thus see that the baffle plate 6 in combination with the particular formation of the enclosed trough performs the full and complete function of the baffle 3 of "Tonner No. 3" and of the cone of the Trumble patent drawings. These inter-related mechanical means thus perform the same function in substantially the same manner and accomplish substantially the same result of delivering substantially all of the oil onto the inner surface of the separator as a backing wall and in a relatively thin film as interpreted by this court in its previous decision.

We respectfully submit that Judge James has erred in his interpretation of the decision of this court as to the scope of the Trumble invention. The "Model 2" trap was utterly devoid of any mechanical means constituting an equivalent for the cone of the Trumble patent or the baffle 3 of the "Tonner No. 3" construction. In Figs. 5 and 6 constructions defendant has not only used the formation of the enclosed trough as a mechanical means for spreading the oil onto the inner curved surface of the wall of the trap, but has provided the additional spreading and directing means of the baffle termination 6 of the trough, to insure that if any oil is flowing on the flat bottom of the trough, that it will, before being discharged therefrom, flow over the angularly disposed baffle and change its course toward and finally be discharged upon the wall of the trap. It is this baffle or angularly disposed plate at the discharge end of the trough that distinguishes the form shown in Fig. 5 and Fig. 6 from that shown in Fig. 4 wherein the outlet or discharge end of the trough is horizontally disposed, and it is this additional spreading means which Lorraine recognized as necessary to use that accomplishes the purpose and object of the Trumble cone and results in insuring that the oil will be spread on the inner wall of the gas trap. It is believed that the function and mode of operation thereby intended to be and actually secured, is evident; we submit that this construction is to be viewed in the light of defendant's many unsuccessful experiments with constructions not embodying such obvious dependence upon complete direction and delivery of all of the oil onto the wall of the trap in a quiescent condition, down which it flows in a relatively thin film.

It is obvious that with the type Fig. 5 or 6 construction defendant does not intend to and does not in mechanical fact depend upon any major portion or a material portion of the oil being delivered into the bottom of the tank in drops or streamlets; on the contrary, judging defendant's intentions and the results secured by defendant by the mechanical means used and the mechanical evidence existent from the various experimental types produced by defendant, the conclusion irresistibly follows that the success of the defendant's Fig. 5 and/or 6 traps is due to such traps incorporating the inventive idea which this court has recognized, and that such traps infringe. This, without any extension whatever of the scope of the Trumble invention beyond that heretofore adjudicated by this court.

In the opinion of the lower court Judge James has described two hypothetical forms of gas traps, which were not before the court, as examples of forms of traps which would not infringe the Trumble patent. [See last paragraph of page 145 of the Record.] With respect to the first of these traps the court stated that the "oil would be directly projected against the wall of the shell, so that it formed approximately a continuous film, which would flow down the surface" and with respect to the second trap stated "the whole effect being to cause the oil to run down the inner surface of the shell in a more or less continuous sheet." These illustrations by the court of non-infringing forms of gas traps is followed by the following statement:

"These illustrations serve to emphasize the fact that it is the *form of apparatus* that gives to the Trumble device its distinction and novelty." (Italics ours.)

Judge James in arriving at his conclusions shows clearly that he was concerned with form whereas this court, as shown by its opinion, considered the matter in substance. Judge James took the "form" shown by Towner #3 as the measure for determining whether the present Lorraine type as shown in Figs. 5 and 6 infringed the Trumble patent and lost sight of the fact that this court defined the scope of the claims in substance as including "an apparatus by which substantially the whole body of oil is spread as a film or thin sheet on a backing wall, and is not, in the course of the process of separation, broken up by any means into drops or streamlets;" and only pointed out that as an example the Towner #3 came within its definition of the scope of the Trumble invention. Had Judge James used the definition of the scope of the Trumble invention as defined by this court and as stated above defendants' traps Figs. 5 and 6 would be found to come squarely within the scope of the Trumble invention as defined by this court.

It is well settled law that "one does not escape liability for infringement by changing the form or dimensions of the parts of a patented combination, where such change does not break up or essentially vary the principle or mode of operation pervading the original invention."

Dowagiac Co. v. Superior Drill Co., 115 Fed. 886-904;

citing :

Cochrane v. Deener, 94 U. S. 787;

Morey v. Lockwood, 8 Wall. 230;

Elizabeth v. Paving Co., 97 U. S. 126;

Loom Co. v. Higgins, 105 U. S. 585;

Nat'l Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 106 F. 693.

It is not necessary, in view of the pleadings and of the prior adjudication of the validity and scope of the Trumble patent and invention, for plaintiffs to rely in this case upon the estoppel by license which bars defendant from asserting invalidity of the Trumble patent, even if that were a litigable issue in this suit. It is a fact that defendant is a licensee of the plaintiffs under the Trumble patent in suit; it retains such license and is limited by the terms thereof; it cannot, while retaining such license, be heard to dispute the validity of the patent.

McLaren Products Co. v. Cone Co., 7 Fed. (2d) 120;

Chadeloid Chemical Co. v. Charles McAdams Co., 298 Fed. 713.

While it is a fact that this case is before this court upon an appeal from a motion for a temporary injunction, it is also a fact that the patent in suit has been sustained against all defenses which are now raised against it, and that by a decision of this Court of Appeals of the 9th Circuit. Without regard, therefore, to the question of *res adjudicata*, this is a proper case for an injunction. (*Kings County Raisin and Fruit Co. v. U. S. Consolidated Seeded Raisin Co.*, 182 Fed. 59 (C. C. A. 9th Cir.)) The decision of Judge James is upon the merits; there is no issue of fact yet to be tried. But, it is also obvious that the grounds of Judge James' decision are not affected by any issue of fact that is to be determined. Judge James' decision is not predicated upon any issue of fact. Both parties submitted the case in the court below for a decision on the merits of the controversy, to avoid any further expense. It is submitted that the

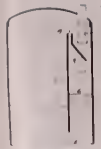
record is sufficient to enable and justify this court's rendering such a decision. It is necessary in view of Judge James' interpretation of the prior decision of this court that this court shall consider the case upon its merits.

Plaintiffs respectfully submit that the gas traps of Fig. 5 and Fig. 6 construction are infringements of claims 1, 2, 3 and 4 of the Trumble patent, as the same have been construed by this court in its previous decision.

We refrain herein from discussing any of the prior art, believing that it is wholly unnecessary to burden the court therewith in view of this court's previous consideration thereof, and of its conclusions. Plaintiffs respectfully submit that the order appealed from, denying the injunction as prayed, be reversed and the cause remanded with instructions to grant such injunction.

Respectfully submitted,

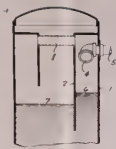
LYON & LYON,
FREDERICK S. LYON,
LEONARD S. LYON,
FRANK L. A. GRAHAM,
HENRY S. RICHMOND,
Attorneys for Appellants.



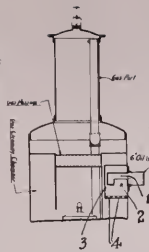
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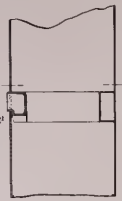
MODEL NO 2 WITH THE SO CALLED NIPPLE MACHINED OFF SO AS TO "FIT CLOSELY AGAINST THE PARTITION WALL



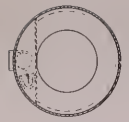
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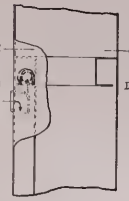
Section through A-A



A-1
FIG. 1



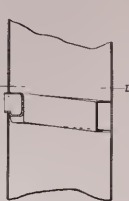
Section through C-C



A-2
FIG. 2



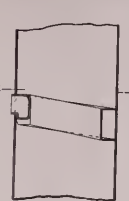
Section through B-B



A-3
FIG. 3



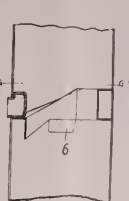
Section through E-E



A-4
FIG. 4



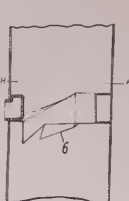
section through G-G



A-5
FIG. 5



section through H-H



A-6
FIG. 6

